

REMARKS

Prior to entry of this response, Claims 1-45 were pending in the application. By this response, no claims are added, canceled, or amended. Hence, Claims 1-45 are pending in the application upon entry of this response.

SUMMARY OF THE REJECTIONS/OBJECTIONS

Claims 1-45 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by “Oracle® Internet File System Developer’s Guide”, Release 1.1, published in September 2000 (“*iFS-Dguide 1.1*”); and Claims 1 and 24 were doubly rejected under 35 U.S.C. §102(b) as allegedly anticipated by *iFS-Dguide 1.1*.

No separate argument is provided herein for these prior art rejections because these rejections necessarily fail if the claim of priority is acknowledged (because the art that serves as the basis for the rejections ceases to qualify as prior art).

PRIORITY CLAIM

SUFFICIENCY OF THE DISCLOSURE OF THE INSTANT APPLICATION

The Office Action did not acknowledge the priority claim to parent application (09/853,823) as a continuation-in-part. Specifically, the Office Action indicated that the priority claim was rejected because the Applicants failed to “show how and where the disclosure of the **instant application** is sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112 to be categorized as a CIP.”

Thus, the sufficiency of the disclosure of the “**instant application**” appears to be the basis for the rejection. With respect to the instant application (the application that is claiming

CIP status), the content requirement is simply that application must repeat “a substantial portion or all of the earlier nonprovisional application”. (see MPEP 201.8)

In response, the Applicants point out that:

- (a) the instant application incorporates by reference the entire disclosure of the parent application (application number 09/853,823, which has now issued as patent number 7,185,005) and
- (b) both the instant application and the parent application incorporate provisional application number 60/204,196 by reference.

Specifically, the instant application, as filed, states:

PRIORITY CLAIM AND CROSS-REFERENCE TO RELATED APPLICATIONS

This application is related to and claims domestic priority from prior U.S. Patent Application Serial Number 09/853,823, filed on May 11, 2001 entitled “Nested Transactions in a File System”, by David Long and David Pitfield, which claims domestic priority from prior **U.S. PROVISIONAL APPLICATION SERIAL NUMBER 60/204,196**, filed on May 12, 2000 entitled “Techniques and Features of an Internet File System”, by David Long. **The entire disclosure of both of these documents is hereby incorporated by reference as if fully set forth herein.**

The parent, as filed, states:

PRIORITY CLAIM AND CROSS-REFERENCE TO RELATED APPLICATIONS

This application is related to and claims domestic priority from prior **U.S. PROVISIONAL PATENT APPLICATION SERIAL NUMBER 60/204,196** filed on May 12, 2000 entitled "Techniques and Features of an Internet File System", by David Long, **the entire disclosure of which is hereby incorporated by reference as if fully set forth herein.**

It is respectfully submitted that these incorporation by references fully comply with all requirements, as elaborated in MPEP 601.08(p) and 37 CFR 1.57. Due to the incorporation of the parent application into the instant application, the disclosure of the present application clearly repeats a substantial portion of the parent application.

It should be noted that the effectiveness of the incorporation by reference does not hinge in any way on the priority claim. Therefore, it cannot be said that the disclosure of the instant application is insufficient because of the rejection of the priority claim (which rejection is based on the proposition that the disclosure of the instant application is insufficient...). Such reasoning would be both legally wrong, and circular.

By identifying these incorporations by reference, it is respectfully submitted that the Applicant has identified both “how and where” the disclosure of the present application is sufficient to satisfy the requirement that the disclosure of the instant application repeat “a substantial portion or all of the earlier nonprovisional application”.

SUFFICIENCY OF THE DISCLOSURE OF THE PARENT APPLICATION

The present Office Action does not appear to question the sufficiency of the disclosure of the parent application. However, to expedite prosecution, Applicants point out that it would not make sense to question the sufficiency of the disclosure of the parent application. Specifically, it would be logically inconsistent to say that (a) the claims are anticipated by portions of *iFS-Dguide 1.1*, and (b) those same claims are not entitled to the priority date of a provisional that contains effectively the same content as those portions. (Actually, the provisional contains the same content, and much more).

The mapping between those portions of *iFS-Dguide 1.1* and *iFS-Dguide 1.0* (which was contained in the provisional) is shown in the painstakingly-prepared table contained in Applicant’s previous response. By incorporating the provisional, *iFS-Dguide 1.0* was included in the parent application to which priority is sought. Therefore, the parent application contains substantially the same content as those portions of *iFS-Dguide 1.1* that are being used as the basis of the current rejection.

In a nutshell, either those portions describe the claimed invention (in which case the priority claim is good and the prior art rejection is bad), or those portions do not describe the claimed invention (in which case the priority claim may be bad and the prior art rejection is also bad). Applicant does not understand how the Office Action can sustain a position in which the priority claim is bad, yet the prior art rejections are good.

SUFFICIENCY OF THE DISCLOSURE UNDER 112

The Office Action requests for the applicant to “show how and where the disclosure of the **instant application** is sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112 to be categorized as a CIP”. This request mentions both the CIP priority claim and the requirements of 35 U.S.C. 112. However, whether the instant application has disclosure sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112 is really separate from the question of whether the instant application can be characterized as a CIP.

If the disclosure of the instant application did not satisfy the requirements of 35 U.S.C. 112, then the appropriate rejection would be that one or more claims were invalid for failure to satisfy the “enablement” or “written description” requirement. Since the Office Action did not reject any claims based on enablement or written description, then it must be assumed that the reference to 35 USC 112 was in error.

If the reference to 35 USC 112 was not an error, and the Examiner believes that the disclosure of the instant application gives rise to a 35 USC 112 rejection, then the Examiner is invited to issue a non-final action that specifies exactly why the Examiner believes that the disclosure of the instant application fails to satisfy 35 USC 112 (i.e. which claimed elements are not described or enabled by the specification).

CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Date: March 29, 2007



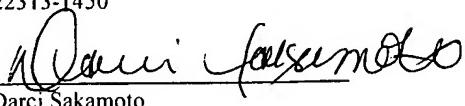
Brian D. Hickman
Reg. No. 35,894

2055 Gateway Place, Suite 550
San Jose, CA 95110-1089
(408) 414-1080
Facsimile: (408) 414-1076

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

on March 29, 2007

by 
Darci Sakamoto